THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on: 29.08.2007

+ **CS (OS) 1192/2005**

PFIZER PRODUCTS, INC. ...Plaintiff

- versus -

MR ALTAMASH KHAN & ANOTHER ...Defendants

Advocates who appeared in this case:
For the Plaintiff : Mr Ankush Mahajan with Ms Anshia
Defendants : Ex parte

CORAM:-
HON'BLE MR JUSTICE BADAR DURREZ AHMED

1. Whether Reporters of local papers may be allowed to see the judgment?

2. To be referred to the Reporter or not?

3. Whether the judgment should be reported in Digest?

BADAR DURREZ AHMED, J (ORAL)

1. The prayers made in the present suit are as under:-

"A. An order and decree of permanent injunction restraining the defendant No.1, his agents, representatives and all those acting on his behalf from, in any manner, using the website 'www.viagra.in'/ domain name, 'viagra.in', or any deceptive variant(s) thereof, so as to amount to passing off of the aforesaid website and domain name as having a connection / affiliation/ association with the plaintiff company;

B. An order and decree of mandatory injunction directing the defendant No.2 to cancel the domain name 'viagra.in' and in the alternative,

direct that the plaintiff be registered by the defendant No.2 as the registrant of the domain name 'viagra.in', of which the defendant No.1 is presently the Registrant;

C. An order for rendition of accounts of profits as prayed for by the plaintiff and a decree for the amount so ascertained;

D. An order and decree for damages in the sum prayed for by the plaintiff.

E. Costs of the suit be awarded to the plaintiff."

The learned counsel appearing on behalf of the plaintiff submits that he is not pressing prayers C and D. Insofar as the defendants are concerned, the defendant No.1 had initially appeared in the proceedings and had also filed a written statement but had subsequently stopped appearing. By an order dated 02.04.2007, it was directed that the suit shall proceed exparte in respect of the defendant No.1. As regards defendant No.2 no specific relief has been claimed and only a direction has been sought in respect of prayer B so that the defendant No.2 may register the domain name "viagra.in" in the name of the plaintiff in place of the defendant No.1.

2. The plaintiff had filed an application being IA No. 6678/2005 under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereinafter referred to as the CPC). At the first hearing, an exparte ad interim order was passed restraining the defendant No.1, its partners, officers,

servants, agents, representatives and all other acting for and on his behalf from using the plaintiff's trademark "VIAGRA" or deceptive variants thereof as part of domain name / or URL registered/ maintained by him which may amount to the passing off of the business and goods of the defendant No.1 as that of the plaintiff. The defendant No.1 was also restrained from selling/ alienating/ transferring to any other third party the domain name "viagra.in" and the URL "www.viagra.in" and the defendant No.2 was restrained from accepting such sale/ transfer alienation. This order was confirmed by the order dated 19.12.2005 which also disposed of IA No. 9942/2005, which was an application filed by the plaintiff praying for the relief that the defendant No.2 be directed to transfer the domain name "viagra.in" to the plaintiff during the pendency of the suit subject to the condition that in the event the suit is decided against the plaintiff and in favour of the defendant No.1, the plaintiff would forthwith take all steps to re-transfer the domain name "viagra.in" to the defendant No.1. Both the applications IA No. 6678/2005 and IA No. 9942/2005 were disposed of by the order dated 19.12.2005, which was an order passed after hearing both the plaintiff and the defendant No.1. While the initial exparte ad interim order was confirmed, the order dated 19.12.2005 also disposed of the said application IA No. 9942/2005 holding that the plaintiff was entitled to an order directing the defendant No.2 to transfer the domain name "viagra.in" to the plaintiff subject to the final decision in the suit and

upon the condition that in case the suit is decided against the plaintiff and in favour of the defendant No.1, the domain name "viagra.in" shall be re-transferred to the defendant No.1 and the plaintiff would be liable to the defendant No.1 for the use of the said domain name and shall suitably compensate the defendant No.1 as may be determined by the Court.

3. Thereafter, the defendant No.2 has transferred the domain name "viagra.in" to the plaintiff and the plaintiff has been using the same. Since the defendant No.1 was proceeded with exparte, the plaintiff was directed to lead its exparte evidence. The plaintiff has filed an affidavit of Ms Anamika Gupta, who is the constituted attorney of the plaintiff by way of evidence. She has essentially stated on affidavit what have been averred in the plaint. At the time when the suit had been filed the plaintiff had indicated that an application for the trademark "VIAGRA" had been filed in India. It is, however, stated in the affidavit by way of evidence that the registration of the trademark has subsequently been done. Paragraph 16 of the affidavit clearly indicates that the plaintiff is now the registered proprietor of the trademark "VIAGRA" in India and its registration number is 710135 in Class 5 relating to pharmaceutical compounds for treating erectile dysfunction. The date of registration is given as 01.06.1996 (as registration dates back to the application date). The plaintiff has been able to establish that the plaintiff is the owner of

the registered trademark "VIAGRA". The plaintiff as registered owner by the trade mark VIAGRA in 147 countries as well as in India and as registered owner of the .com domain name (www.viagra.com) does have a legitimate interest in protecting its brand. The defendant No.1 does not have any interest in the domain name "viagra.in" apart from putting it up for sale. The defendant No.1 does not have any right to the product VIAGRA. Thus, defendant No.1 has no legitimate interest in using the domain name "viagra.in". The domain name "viagra.in" is confusingly similar to the trade mark VIAGRA and the domain name "viagra.com" which belong to the plaintiff. The plaintiff has also been able to establish that it has a right to the domain name "viagra.in".

4. In these circumstances, the suit is decreed in terms of prayer A. Insofar as prayer B is concerned, the defendant No.2 is directed to confirm the registration of the plaintiff for the domain name "viagra.in" and to cancel the registration of the said domain name in respect of the defendant No.1. The suit is accordingly decreed with costs which are quantified at Rs 1 lac.

BADAR DURREZ AHMED
(JUDGE)

August 29, 2007
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